

REMARKS

In the non-final Office Action, the Examiner rejects claims 1, 2, 4-6, 9-11, and 14-16 under 35 U.S.C. § 102(c) as anticipated by L'HEUREUX (U.S. Patent No. 6,697,942); and rejects claims 3, 7, 8, 12, and 13 under 35 U.S.C. § 103(a) as unpatentable over L'HEUREUX. Applicants respectfully traverse these rejections.

By way of the present amendment, Applicants amend claims 1, 6, and 9 to improve form. No new matter has been added by way of the present amendment. Claims 1-16 remain pending.

Rejection under 35 U.S.C. § 102(e) based on L'HEUREUX

Claims 1, 2, 4-6, 9-11, and 14-16 stand rejected under 35 U.S.C. § 102(e) as allegedly anticipated by L'HEUREUX. Applicants respectfully traverse this rejection.

A proper rejection under 35 U.S.C. § 102 requires that a single reference teach every aspect of the claimed invention. Any feature not directly taught must be inherently present. See M.P.E.P. § 2131. L'HEUREUX does not disclose or suggest the combination of features recited in claims 1, 2, 4-6, 9-11, and 14-16.

For example, amended independent claim 1 is directed to a method of preparing a message in an electronic communication device. The method includes providing, via a display of the electronic communication device, a set of message types that can be selected by a user in an editor common for all message types; detecting, via a control unit of the electronic communication device, a message type selection for a user; and changing, via the control unit, transmission format in dependence of the selections made by the user, which provides preparing and saving a message in advance of deciding final

message type for transmission or saving thereof. L'HEUREUX does not disclose or suggest this combination of features.

For example, L'HEUREUX does not disclose or suggest changing, via the control unit, transmission format in dependence of the selections made by the user, which provides preparing and saving a message in advance of deciding final message type for transmission or saving thereof. The Examiner relies on col. 3, lines 1-30, of L'HEUREUX and alleges:

[b]ased on the selected message type the terminal will 'change the transmission format' (the 'text' portion of the data field will be filled with the specific message type data)

(Office Action, p. 2). Applicants respectfully disagree.

At col. 3, lines 1-31, L'HEUREUX discloses:

SUMMARY OF THE INVENTION

The present invention describes a data formatting method for embedding diverse data types in an electronic mail message by forming a network compliant e-mail message header, generating one or more command blocks representing diverse data types, and combining the data types with the message header such that the e-mail message conforms to network standards. In operation, data are edited on and sent from a first system, for example, a subscriber service center, by means of a set of custom message commands. The editing system at the sender's location employs a Graphical User Interface (GUI) enabling non-sophisticated users to create complex mixed data type messages. The mixed data type message may contain commands to reset the configuration of a remote device, for example to change a password or update a device setting. Additionally, other segments, or blocks of the message may contain a graphic image and/or a plain text message. The exact nature of the data depends upon predefined data types.

At the sender's location the mixed data type message is passed from the graphical user interface to a command formatter which translates the GUI output into a custom command format suitable for the receiving apparatus to interpret. A standard e-mail header is then formed and the two parts of the message are combined into e-mail format for transmission. Once in the

proper format, the e-mail message may be transferred over standard e-mail networks using standard e-mail protocols. For example, an e-mail message may be sent over the Internet to a SMTP server using SMTP/MIME protocols. From the SMTP server the message is transferred to the recipient's POP server where it is stored until the recipient downloads it during an e-mail session.

This section of L'HEUREUX discloses embedding diverse data types into an electronic mail message. This section of L'HEUREUX does not relate to changing a transmission format based on selections made by a user. Instead, L'HEUREUX is specifically directed to formatting and sending electronic mail messages (see Abstract). Thus, there would be no need to allow the user to select a transmission format in L'HEUREUX because, in all instances, L'HEUREUX would transmit an electronic mail message. Neither this section nor any other section of L'HEUREUX discloses or suggests changing, via the control unit, a transmission format in dependence of the selections made by the user, which provides preparing and saving a message in advance of deciding final message type for transmission or saving thereof, as recited in claim 1. The embedding of different data types into an electronic mail message, as disclosed by L'HEUREUX, does not result in messages of different transmission formats. Instead, L'HEUREUX's embedding results in one type of message – an electronic mail message. L'HEUREUX does not disclose or suggest changing transmission formats.

Further with respect to claim 1, Applicants note that the Examiner alleges that:

[t]he terminal inherently comprises input means and display means for the purpose of letting the user 'select' any known type of data to be transferred (selecting a message type, and detection of a user selection)

(Office Action, p. 2). Applicants disagree.

Terminal 110 in L'HEUREUX corresponds to an editing terminal, such as a desktop computer (col. 4, line 66 to col. 5, line 2). L'HEUREUX discloses that terminal 110 is used to compose email messages that include the diverse data (col. 4, line 66 to col. 5, line 2). Clearly, L'HEUREUX does not disclose or suggest (inherently or otherwise) input means and display means, as the Examiner alleges, for the purpose of letting a user select a message type. The only transmission format disclosed in L'HEUREUX is the electronic mail message format. The Examiner provides no evidence to support the inherency assertion. Accordingly, the Examiner has not met the burden required to establish a proper case of inherency.

For at least the foregoing reasons, Applicants submit that claim 1 is not anticipated by L'HEUREUX. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claim 1 under 35 U.S.C. § 102(e) based on L'HEUREUX.

Claims 2, 4, 5, 15, and 16 depend from claim 1. Therefore, Applicants submit that these claims are not anticipated by L'HEUREUX for at least the reasons given above with respect to claim 1. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 2, 4, 5, 15, and 16 under 35 U.S.C. § 102(e) based on L'HEUREUX. Moreover, these claims are not anticipated by L'HEUREUX for reasons of their own.

For example, claim 5 recites that the saving a message is performed in a general format. With respect to this feature, the Examiner alleges:

all data must be saved (in a 'general format') at every processing stage in the terminal in order for the data to be processed

(Office Action, p. 3). The Examiner appears to allege that this feature is inherent in the disclosure of L'HEUREUX. Applicants disagree.

Applicants submit that the Examiner has not provided the showing required to establish that the above feature of claim 5 is an inherent part of L'HEUREUX's terminal. M.P.E.P. § 2112 requires the Examiner, when relying on the theory of inherency, to provide "a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). The Examiner has not provided the necessary showing articulated in M.P.E.P. § 2112 to support the inherency assertion. In fact, the Examiner merely provides a conclusory statement that L'HEUREUX's terminal must store data in a general format. Applicants' claim 5, however, is directed to saving the message in a general format prior to deciding a final message type. L'HEUREUX's terminal formats and transmits electronic mail messages only. L'HEUREUX in no way discloses or suggests (inherently or otherwise) that the terminal saves the message in anything other than an electronic mail format, much less, a general format, prior to deciding a final message type, as would be required of L'HEUREUX based on the Examiner's interpretation of claim 5.

If this rejection is maintained, Applicants respectfully request that the Examiner provide evidence to support the allegation that L'HEUREUX's terminal inherently saves the message in a general format prior to deciding a final message type.

For at least these additional reasons, Applicants submit that claim 5 is not anticipated by L'HEUREUX. Accordingly, Applicants respectfully request that the

Examiner reconsider and withdraw the rejection of claim 5 under 35 U.S.C. § 102(e)

based on L'HEUREUX.

Independent claim 6 is directed to a device for preparing a message in an electronic communication device. The device includes a message type selection unit providing a set of message types that can be selected by a user, a first user input unit, for allowing message type selection by the user, and a control unit arranged to provide the set of items of message types that can be selected by a user in an editor having a format common for all message types, detect a message selection by a user via said first user input unit, change the transmission format in dependence of the selections made by the user which provides preparing and saving a message in advance of deciding final message type for transmission or saving thereof. L'HEUREUX does not disclose or suggest this combination of features.

For example, L'HEUREUX does not disclose or suggest a message type selection unit providing a set of message types that can be selected by a user. The Examiner appears to rely on col. 3, lines 1-30, of L'HEUREUX for allegedly disclosing this feature (Office Action, p. 2). Applicants respectfully disagree with the Examiner's interpretation of L'HEUREUX.

Col. 3, lines 1-30, of L'HEUREUX are reproduced above. This section of L'HEUREUX discloses embedding diverse data types into an electronic mail message. This section of L'HEUREUX does not relate to providing a set of message types. Instead, L'HEUREUX is specifically directed to formatting and sending electronic mail messages (see Abstract). Thus, there would be no need to provide a set of messages types in L'HEUREUX because, in all instances, L'HEUREUX would transmit an

electronic mail message (thus no selection of message type is needed). Neither this section nor any other section of L'HEUREUX discloses or suggests a message type selection unit providing a set of message types that can be selected by a user, as recited in claim 6. The embedding of different data types into an electronic mail message, as disclosed by L'HEUREUX, does not result in messages of different types. Instead, L'HEUREUX's embedding results in the same type of message – an electronic mail message. L'HEUREUX does not disclose or suggest the above feature of claim 6.

L'HEUREUX does not further disclose or suggest a control unit arranged to change the transmission format in dependence of the selections made by the user which provides preparing and saving a message in advance of deciding final message type for transmission or saving thereof, as also recited in claim 6. This feature is similar to (yet possibly of different scope than) a feature described above with respect to claim 1. Therefore, Applicants submit that L'HEUREUX does not disclose or suggest the above feature of claim 6 for at least reasons similar to reasons given above with respect to claim 1.

For at least the foregoing reasons, Applicants submit that claim 6 is not anticipated by L'HEUREUX. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claim 6 under 35 U.S.C. § 102(e) based on L'HEUREUX.

Claims 9-11 and 14 depend from claim 6. Therefore, Applicants submit that these claims are not anticipated by L'HEUREUX for at least the reasons given above with respect to claim 6. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 9-11 and 14 under 35 U.S.C. § 102(e)

based on L'HEUREUX. Moreover, these claims are not anticipated by L'HEUREUX for reasons of their own.

For example, claim 9 recites a feature similar to (yet possibly of different scope than) a feature described above with respect to claim 5. Therefore, Applicants submit that claim 9 is not anticipated by L'HEUREUX for at least reasons similar to reasons given above with respect to claim 5. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claim 9 under 35 U.S.C. § 102(e) based on L'HEUREUX.

Rejection under 35 U.S.C. § 103(a) based on L'HEUREUX

Claims 3, 7, 8, 12, and 13 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over L'HEUREUX. Applicants respectfully traverse this rejection.

Claim 3 depends from claim 1. Therefore, this claim is patentable over L'HEUREUX for at least the reasons given above with respect to claim 1. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claim 3 under 35 U.S.C. § 103(a) based on L'HEUREUX.

Claims 7, 8, 12, and 13 depend from claim 6. Therefore, these claims are patentable over L'HEUREUX for at least the reasons given above with respect to claim 6. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 7, 8, 12, and 13 under 35 U.S.C. § 103(a) based on L'HEUREUX.

Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request the Examiner's reconsideration of this application, and the timely allowance of the pending claims.

PATENT

U.S. Patent Application No. 10/576,474

Attorney's Docket No. PS02 0184WO1

As Applicants' remarks with respect to the Examiner's rejections are sufficient to overcome these rejections, Applicants' silence as to assertions by the Examiner in the Office Action or certain requirements that may be applicable to such assertions (e.g., whether a reference constitutes prior art, reasons to modify a reference and/or to combine references, assertions as to dependent claims, etc.) is not a concession by Applicants that such assertions are accurate or such requirements have been met, and Applicants reserve the right to analyze and dispute such assertions/requirements in the future.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-1070 and please credit any excess fees to such deposit account.

Respectfully submitted,

HARRITY & HARRITY, LLP

By: /John E. Harrity, Reg. No. 43367/
John E. Harrity
Registration No. 43,367

Date: December 29, 2008

11350 Random Hills Road
Suite 600

Fairfax, Virginia 22030

(571) 432-0800

Customer Number: 58561